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07/422,699 10/17/89 RUEGER

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153

08/24/90

☐ This application has been examined ☒ Responsive to communication filed on 11 June 1990 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1, 2, 4-19 and 21 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 3, 20 and 22-27 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1, 2, 4-19 and 21 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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The election of species of Paper No. 8 is hereby expressly withdrawn.

Claims 3, 20 and 22-27 have been cancelled by Applicants' response, Paper No. 10.

Claims 1, 2, 4-19 and 21 remain in the application.

The rejection under 35 USC 103 over Urist ('256) or Nathan et al ('350) is hereby expressly withdrawn.

Claims 1, 2, 4-19 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-19 recite "invention" without specifically reciting what invention, i.e. protein, is intended. The word has no antecedent basis in the claims from which they ultimately depend.

Claim 21 refers back to Figure 18 which does not fulfill the requirement of 35 USC 112, second paragraph in that the claim is not written in clear and concise language so as to be self-contained. Note 37 CFR 1.75(a).

While not formalized into a rule, there is a long-standing policy and practice in the Office that a claim should be self-contained to the extent possible to fulfill the statutory requirement of particularly pointing out and distinctly claiming what applicant regards as his invention. This practice facilitates examination of the claimed invention by having the

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subject matter all in one place, avoids complicating the examination process by adding the processing of drawings and possible correction thereof to the Office procedures, and permits the claimed subject matter to be easily modified without possible correction of drawings and potential modification of the scope of the disclosure as originally filed. The long standing practice also serves the public by placing the claimed subject matter in one location without having to refer back and forth to at least two different places.

Claims 1, 2 and 4-9 recite only the sequence of one of the dimeric pairs, and is not indicative of the other protein pair component.

Claim 21 recites a protein but provides no recitations as to any given aspects, such as molecular weight, elution characteristics, isoelectric point, etc. Which would be clearly indicative to a skilled artisan what protein is intended. Neither are such characteristics provided in any other claims which would be clearly indicative of the proteins intended.

The term "sufficiently duplicative" in claim 21 is vague since "sufficiently" is qualitative rather than quantitative.

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

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Claims 1, 2, 4-19 and 21 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 21-45 and 51 of copending application Serial No. 315,342. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

The claims of the copending application have not been cancelled.

Claims 1, 2, 4-19 and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-45 and 51 of copending application Serial No. 315,342. Although the conflicting claims are not identical, they are not patentably distinct from each other because the mode of production, i.e. recombinant technology, solid phase synthesis, etc. is irrelevant since the proteins are essentially identical or would appear to be so.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

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Claims 1, 2, 4-19 and 21 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 32-53 and 62 of copending application Serial No. 232,630. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

Claims 1, 2, 4-19 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-53 and 62 of copending application Serial No. 232,630. Although the conflicting claims are not identical, they are not patentably distinct from each other because no differences have been shown on the record as to the proteins of the instant claims and those recited in the claims of the copending application.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Due to the new grounds of rejection. this Action is not being made FINAL.



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August 23, 1990
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PATENT EXAMINER
ART UNIT 153

08-22-90